

No. 11008.

IN THE  
**United States Circuit Court of Appeals**  
FOR THE NINTH CIRCUIT

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OTTO H. KRUGER,

*Appellant,*  
*vs.*

NED WHITEHEAD, doing business under the fictitious name  
of Whitehead & Co.,

*Appellee.*

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**APPELLEE'S BRIEF.**

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APPELLEE'S BRIEF.

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This case comes before this Court upon an appeal from the final judgment of the United States District Court for the Southern District of California adjudging the Ballou Patent No. 2,088,567, and particularly Claims 1, 2, 4 and 5 thereof, invalid, and enjoining Appellant "from further representing to the trade, and particularly to Plaintiff's customers, that identification cards manufactured by Plaintiff are an infringement of, or that any use of said trade or customers is an infringement" of said patent [R. 25].

Appellee filed an action in the District Court alleging that an actual controversy existed between Appellant and Appellee respecting the validity of said patent and the alleged infringement thereof by Appellee, and asked a judgment against Appellant that the patent was invalid and that Appellee had not infringed it [Complaint R. 3,

6]. Appellant answered admitting Plaintiff's assertion that such actual controversy existed between Appellant and Appellee [Answer R. 13], and counter-claimed against Appellee asserting the validity and infringement by Appellant [R. 15], praying a final injunction against further infringement by Appellee, etc. [R. 15]. Appellee in his answer to such counter-claim pleaded the invalidity of the patent [R. 16-18].

### **Jurisdiction.**

Jurisdiction of the District Court and of this Court to hear this appeal is clear. The appeal was timely. *The Declaratory Relief Act, Judicial Code, Sec. 274(d), 28 U.S.C.A. 400*, establishes jurisdiction of Appellee's declaratory judgment action, and the District Court had exclusive jurisdiction to determine the issues of validity and infringement of the patent, which arose under the patent laws of the United States (Judicial Code, Sec. 41).

### **Statement of the Case.**

#### **The Ballou Patent:**

The Ballou patent describes and claims a composite card. The purpose of this card is to serve as a means of identification. Such identification may be of a person or other object. Nothing in the patent claims limits the card to any novel thing which identifies a human being from any other animal or thing. To prevent alteration the identification card proper is enclosed within and united with a transparent cover. Such cover is composed of a material that can be removed by a solvent. The print-

ing on the card is in ink or in coloring matter that will be destroyed or defaced by the action of the solvent in removing the cover. [Ballou Patent, R. 45, p. 1, col. 1, *ll.* 45-55].

It is admitted that the cover commercially used on Appellant's and Appellee's cards is cellulose acetate [R. 88, Answer to Dfts. Interr. No. 1; R. 73-74].

The subject matter of this patent is an article of "manufacture", as distinguished from "an article", "machine", or "composition of matter" (R.S.U.S. 4886; 35 U.S.C.A. Sec. 31), and "nothing short of invention or discovery will support a patent for a manufacture any more than for an article, machine or composition of matter, for which proposition there is abundant authority in the decisions of this court." (*Union Paper Collar Co. v. Van Deusen*, 90 U.S. 530, 23 L. ed. 128, at 133.)

The patent describes the so-called "identification card" as consisting of a transparent cover within which a card is enclosed, this card being imprinted with, or otherwise carrying, what is termed in the patent "distinguishing matter." The patent does not disclose any novel kind of card, either with respect to material, shape or construction, nor any novel distinguishing matter serving identification purposes. The sole claim of invention is the imprinting of the distinguishing matter (of whatever character) upon the enclosed card in an ink or coloring matter which dissolves when the dissolving solvent of the transparent cover is applied thereto. [Cf. Ballou Patent, R. 45, p. 1, col. 1, *ll.* 47-55.]

"\* \* \* the point is that the identification matter will always be made of a medium dissolvable by the same solvent by which the cover can be dissolved,

so that no identification matter will be left on any attempt of dissolving the cover for the sake of obtaining the identification for misrepresentation or alteration." [Id., col. 2, ll. 4 to 10.]

Ballou and Appellant admitted that there was nothing novel in this identification card except the imprinting or forming of the so-called distinguishing matter of an ink or coloring which would dissolve by the same solvent that would dissolve the cover, and Appellant is estopped to contend otherwise. [Cf. rejected and cancelled Application Claim 6, R. 52; testimony of appellant, R. 63.]

The card defined by Claims 1, 2, 4 and 5 of the Ballou patent differs from this admittedly old card of cancelled Application Claim 6 *solely* in printing or forming of the so-called "distinguishing matter" of a material "made to dissolve by the same solvent" that will dissolve the cover.

(*I. T. S. Rubber Co. v. Essex Rubber Co.*, 272 U.S. 429, at 443, 444; *Hubbell v. United States*, 179 U.S. 75; *Brill v. St. Louis Car Co.*, 90 Fed. 666, C.C.A. 8.)

**The Goodsell-Maynard Patent**  
1,071,226 [Plaintiff's Exhibit 3,  
R. 138-140].

This patent discloses an identification card enclosed in a celluloid cover. This cover is attached to the card in the same manner as the cover in the Ballou patent [Cf. R. 140, Goodsell-Maynard Patent, p. 2, ll. 5 to 45; Id. 139, ll. 20-26].

The Goodsell-Maynard Patent does not disclose what kind of ink or coloring matter is or may be used for printing upon the card or identifying device 4.

No Ink Known Which Is Not  
Defaced by Solvent.

In deciding this case the District Judge accepted the testimony of Appellant's expert Horwitz, who testified that manufacture of an ink that would *not* bleed has been and still is a problem [R. 105].

"Q. Then there is no ink which could be applied, even today, to cards in these cellulose acetate covers, under heat and pressure, which, upon dissolving the cellulose acetate covers, could be re-coated, without destruction of the printed matter. A. Not without so defacing it that it would be easily recognizable as having been tampered with." [R. 106.]

\* \* \* \* \*

"The Court: In other words, it has been generally known that there was a solvent that would cut printed matter? A. That is right.

The Court: It is also well known, isn't it, that there is a solvent that will dissolve celluloid material. A. Yes. That also goes back many, many years.

The Court: To a man skilled in the profession there is nothing about the ink combinations here that is unusual? A. No. It hasn't been unusual for the past 20 years anyway, maybe longer than that. My recollection goes back to the years I was working in the press room, when they were making identification tabs. At the old John C. Moore Corporation in New York City, we were playing around in those days with the fusing together of two parts of celluloid, having a gummed flag of fabric attached to it. That goes back to 1910 and 1911.

The Court. Has there ever been a time when you have before been confronted with the problem of working out an identification card? A. No, sir.

The Court: Is that the first time? A. This is the first time, to my knowledge, and, if I may elaborate on that a little bit, I have covered the graphic arts field for 40 years now, *and there has never been a time or an industry other than the one created by the present emergency that made that kind of thing necessary and essential. In this war they have found this kind of thing completely essential and necessary in the creation of small industries, this identification proposition.*" [R. 102, 103; emphasis supplied.]

\* \* \* \* \*

"No printing ink has yet been made that will withstand the action of acetate solvent. All vehicles that are used in printing ink will break down under the action of any acetate solvent." [R. 95.]

\* \* \* \* \*

"The Court: I understand from your testimony that, generally speaking, any celluloid material that can be dissolved or that is susceptible of dissolving, the solvent would also affect the ink? A. The same solvent would affect the ink, yes, and I think the word 'affect' is used advisedly there, because it would affect it in varying degrees. In some instances it will take it out completely, and in others it will take it out in more modified ways and in other cases it would destroy the fabric of that ink. The ink is no longer the same after it has been hit by that solvent.

The Court: I think that is all.

*Redirect Examination.*

Q. By Mr. Franklin: You say that different solvents affect the ink to different degrees. That being the case, would you say that all solvents that would dissolve cellulose acetate would be sufficient to

dissolve the ink in such a way that it would show up on the card to show that it had been tampered with? A. I would say that any solvent that will take that cellulose acetate off would affect the printed matter there to a degree that it would show tampering." [R. 110.]

The problem in ink manufacture was not to produce an ink which would not bleed or run or be defaced in a cellulose solvent. The difficulty with the earlier inks was this bleeding and dissolving. Appellant's expert, Horwitz, made this clear:

"Q. Is it not true that for 20 odd years or much longer that ink problems have had to do with producing a fixed ink? A. Will you explain what you mean by a 'fixed ink'?"

Q. An ink that would not dissolve, bleed or leach in alcohol esters? A. It is still a problem.

Q. You haven't succeeded ever in manufacturing a fixed ink? A. Not for the printing and lithographic arts, industries, no." [R. 104.]

**The Walsh-Caprio Patent**

**2,079,641 [R. 154-6].**

This patent discloses a process of making an integral structure or manufacture comprising "a plurality of sheets at least one of which is of cellulose acetate plastic, and at least one of which bears bleeding colors, said sheets joined by means of a sheet of cellulose acetate plastic containing at least 60 parts plasticizer to 100 of cellulose acetate base between each pair of said first mentioned sheets." [Claim 4, R. 156.]

The product produced by the Walsh-Caprio process results in the production of an article of manufacture substantially identical with the article defined by the Ballou patent claims. The application for this patent was filed January 11, 1930, almost four years prior to the filing, on October 22, 1934, of the application for the Ballou patent. [Cf. certified copy Walsh-Caprio application, Pltfs. Ex. 8.] All that was set forth in such application was made a part of the prior knowledge by the filing of such application and is thereby proven to have been known prior to Ballou's alleged invention. (*Alexander Milburn Co. v. Davis-Bournonville Co.*, 270 U.S. 390.) This patent was not considered by the Patent Office in the negotiations for the grant of the Ballou patent and the usual presumption of validity of the Ballou patent is thereby overcome and the court called upon to determine the issue of invention as a matter of first impression. (*Mettler v. Peabody*, 77 F. 2d, 56, 58, C.C.A. 9.)

The Walsh-Caprio patent states that: "An object of our invention, therefore, is to provide a cement which will not cause blushing, bubbles or pockets and will not cause colors to run or bleed." [R. 155, Col. 1, ll. 19-22.]

The drawings show a print or card 1 "having a paper base" and "having an outer color surface." [R. 155, col. 1, ll. 44-47.]

"It is assumed for the purposes of illustration that the color or colors of the print 1 have a tendency to run or bleed when the ordinary volatile liquid

solvents or cements are used. To overcome this tendency of the colors to run or bleed, we use between sheet 4 and print 1, a cement 5 in sheet form comprising substantially non-volatile solvents for the cellulosic plastic, preferably combined with at least a small proportion of the particular cellulosic plastic. The presence of at least a small proportion of the cellulosic plastic is particularly preferred where the non-volatile solvents are of an oily nature, in order that the cement may be maintained in sheet or other solid form. The use of a proportion of the cellulosic plastic also aids in producing a final product which is substantially homogeneous throughout, except for the print or its equivalent." [R. 155, col. 1, *l.* 54, to col. 2, *l.* 12.]

The patent contains complete formulae setting forth in detail the composition of the so-called thermoplastic cements. Formulae A and C refer to cellulose acetate and Formulae B and D refer to cellulose nitrate as the main ingredients, and the other chemicals in the formulae as plasticizers or thinners. "Cellulose acetate" and "cellulose nitrate" as well as celluloid are well known clear, plastic substances, all usable for covering the surface of an identification card. They have no visible physical differences. Either of these correspond with exactitude to celluloid or the "different transparent materials" which may be used instead of celluloid as set forth as equivalents in the Ballou patent. Plaintiff uses cellulose acetate in covering his cards. Further reference to the soluble or bleeding or smearing character of the color or ink is

contained in this Walsh-Caprio disclosure [p. 2, col. 1, ll. 21-28, R. 156] and it is to be noted that in the article, claims 3 and 4 [R. 156] which claim the composite sheet produced, reference is made to one of the sheets which bears bleeding colors. There is no substantial patentable difference between the Ballou identification card, as defined and disclosed in Ballou's patent claims, and the composite sheet or identification card produced in accordance with the Walsh-Caprio disclosure.

The fact that the print 1 of the drawing of the patent is a picture is wholly immaterial as to anticipation of the Ballou patent. Such illustration would be an identification means for identifying a person or property illustrated. Clearly, it would not amount to invention to substitute for this pictorial representation a man's name in printing or any other identifying matter. Appellee cannot stress too much the fact that the Ballou patent does not disclose or claim any particular identifying manner or means. The material consideration here is that in law the use of the card cannot form the basis for either patentable novelty or patentable invention *in the card itself*. It is not the use of the card that renders the card patentable, but it is the elements from which it is constructed. The Walsh-Caprio patent [Ex. 7] describes as well as claims, the things which the Ballou patent claims. The only material difference between the patents to Walsh and Caprio and to Goodsell and Maynard [Ex. 3] is that Walsh and Caprio recognize that *inks will bleed* when subject to the solvents and plasticizers necessarily

present in a cellulose cover, and that Walsh and Caprio disclose a cement between the cover and the card which will prevent the ink from bleeding during the manufacture. The article produced by the Walsh-Caprio process corresponds precisely with the so-called "identification card" of the Ballou patent claims. "\* \* \* the color or colors of the print 1" are described as having "a tendency to run or bleed when the ordinary volatile liquid solvents or cement are used." [R. 155, col. 1, ll. 54-57.] "The compositing operation is preferably carried on by first using heat and pressure in a press, or its equivalent, and then cooling without completely removing the pressure." [Id. col. 2, ll. 19-22.]

Four formulae are given of a thermoplastic cement which is termed as "plasticizer". If cellulose acetate is used as a solvent to dissolve or remove the cellulosic cover, such solvent being a solvent of both the plasticizer and the ink or coloring matter, the fact is established that "it would be easily recognizable as having been tampered with." [Horwitz' testimony, *supra*, R. 106.]

#### **Grounds of the District**

#### **Court's Decision.**

"If the evidence offered by the patent holder is to be accepted, we have no discovery and therefore no patent, while on the other hand, if plaintiff's testimony is to be accepted by the court, we have a problem stated without the solution. Under either viewpoint the patent is clearly invalid.

“In view of the presumption of validity, I am accepting the testimony of the patent holder's expert. The defendant patent holder by attempting to prove his patent complies with R.S.U.S. 4888 has convinced the court that his patent is not the result of inventive genius but at the most required only the work of one skilled in the art. As a matter of fact, I feel no discovery was made. The problem according to the defendant, was the finding of certain inks that would be dissolved or caused to bleed by the same solvent that would dissolve the transparent covering. The solvents for the coverings were well known, and if, as a matter of fact, all inks would be substantially affected by such solvents, the problem of discovering the proper ink did not exist.” [Opinion District Court, R. 21.]

### **The Questions Involved.**

Appellee cannot accept Appellant's statement of the questions herein involved, but submits that the determination of the following questions require affirmance of the appealed judgment:

1. Was the District Court in error in concluding that the production of the so-called “identification card” defined in claims 1, 2, 4 and 5 of the Ballou patent, did not require patentable invention?
2. Does the written description and the disclosure of the Ballou patent comply with the requirements of the Patent Statute R.S.U.S. 4888, 35 U.S.C.A., Sec. 33? If not, the patent is void.

## SUMMARY OF ARGUMENT.

**The District Court Was Correct  
in Concluding That the Ballou Patent  
Did Not Disclose Patentable Invention.**

Ballou is not the first inventor or discoverer of printing identifying or distinguishing matter upon a card nor of enclosing such a card in a celluloid cover or envelope. This was fully disclosed in the Goodsell-Maynard Patent. Ballou was not the first inventor of a bleeding ink nor of a solvent which would dissolve celluloid and in dissolving it deface or dissolve the ink.

It is not invention to select a material and substitute it in an old environment in order to avail of the particular known properties of such substituted material.

The Ballou patent is void in view of the Goodsell-Maynard patent.

The Ballou patent is completely anticipated by the product produced by the Walsh-Caprio patent.

**The Ballou Patent Is Invalid as Not  
Complying With the Requirements of the  
Patent Statute R.S.U.S. 4888, 35 U.S.C.A., Sec. 33.**

Was the District Court in Error in Concluding That  
the Production of the So-called "Identification  
Card" Defined in Claims 1, 2, 4 and 5 of the  
Ballou Patent, Did Not Require Patentable In-  
vention?

The Ballou patent describes an article of manufacture entitled "An Identification Card" which has three elements, (1) a cover that can be dissolved by a solvent; (2) a card disposed under the cover, and (3) distinguishing matter (upon the card) formed of an ink or coloring matter so constituted as to dissolve with the same solvent that dissolves the card [Claim 1 of Ballou patent, R. 46-47]. The other claims in suit, 2, 4 and 5, merely set forth the same elements in different language. They do not call for any additional or different things. The law requires that the patentee "particularly point out and distinctly claim the part, improvement or combination which he claims as his invention." (R.S.U.S. 4888, 35 U.S.C.A. §33.)

In law, the claim or claims of a patent are the definition of the invention. The claim prescribed by the Statute is for the purpose of making the patentee define precisely what his claimed invention is. (*Corn Products Ref. Co. v. Penick & Ford*, 63 F. 2d, 26, 31.) "Under the statute, it is the claims which define the invention \* \* \* and each claim must stand or fall as itself sufficiently defining invention, independently of the others." (*Altoona Publix Theatres, Inc. v. American Tri-Ergon*, 294 U.S. 477, 487, 79 L. ed. 1005, 1012.) (Cf. *Rip Van Winkle W. B. Co. v. Murphy W. B. Co.*, 1 F. 2d, 673, 676, C.C.A. 9; *Continental Paper Bag Co. v. Eastern Paper Bag Co.*, 210 U.S. 405, 419, 52 L. ed. 1122, 1128; *Henry v. City of Los Angeles*, 255 F. 769, 780, C.C.A. 9.)

The only definition contained in any of the Ballou patent claims is the one just given and the District Court correctly so found in its Finding of Fact VIII [R. 33].

The Goodsell and Maynard patent, Plaintiff's Exhibit 3 [R. 138-140] is a complete anticipation of the alleged Ballou invention. This prior patent illustrates and describes a label. This label is formed of two sets of transparent substances, such as celluloid, between which is placed a card or label proper upon which there are marked identifications and the sheets of celluloid and paper subjected to heat and pressure to form a unitary structure. [Pltf's. Ex. 3, R. 139, col. 2, ll. 1-83.] There is no difference between a label and an identification card. The card can equally well be used to identify the variety of tree, plant, etc., as it can be to identify a human being. None of the Ballou claims point out or distinctly claim any part of his so-called identification card which distinguishes the Ballou card from the Goodsell and Maynard label. The claims of the Ballou patent specify only distinguishing matter made of the same solvent as will dissolve the cover. The undisputed testimony of the Appellant's expert is that all ink will dissolve and be defaced by the solvents for celluloid or the cellulose acetate cover [R. 106, 110]. As the testimony of Appellant's expert witness is true and undisputed at any place in the record, the solvents that would dissolve the cover of the Goodsell and Maynard patent would affect the ink (e.g., in which the words "Red Oak" are printed) and to a degree that would show tampering [R. 110]. In the patent law sense there is no differentiation in kind between the composite card of the Ballou patent and this Goodsell and Maynard label. The Ballou patent is not limited to novel means of identification. Compare Goodsell and Maynard description [R.

139, col. 2, *ll.* 89-98] : "The interposed identifying device, as it has been termed, may bear printing on both sides. For instance, in the case of a horticultural label, on one face of the identifying device could be printed the name of a flower or something of a similar character or even a symbol, while the opposite face might bear advertising matter of a florist or nurseryman."

As said by the Supreme Court in *Ferdinand De St. Germain v. Emanuel Brunswick*, 135 U.S. 227:

"This case falls within the familiar rule that the application of an old process or machine or apparatus to a similar or analogous subject, with no change in the manner of application, and no result substantially distinct in its nature, will not sustain a patent, although the new form of result may not have before been contemplated."

As said in *Guthrie v. Curlett*, 10 F. 2d, 725, C.C.A. 2:

"A new method, art or process of making directories, dictionaries, encyclopaedia, or other compendious statements of written information, may be both new and useful, but the patent law is prosaically practical, it can never get away from the necessity of means, and unless patentable means of expressing or using the new idea are shown, there can be no valid patent."

The Ballou patent neither illustrates nor describes nor claims any thing novel constituting a means for identification. The use, as a means for identification, of photographs, finger-prints, a description of the individual, name, age, place of birth, etc. on a card was in common use. Therefore, this distinction so attempted by defendant completely evaporates from the case.

It is well settled that

“ ‘It is not the result, effect, or purpose to be accomplished which constitutes an invention, but the mechanical means or instrumentalities by which the object sought is to be attained.’ Kohler v. Cline Electric Mfg. Co. (D.C.) 28 F. (2d) 405, 406. ‘The thing patented is the particular means devised by the inventor by which that result is attained, leaving it open to any other inventor to accomplish the same result by other means.’ Electric R. Signal Co. v. Hall Ry. Signal Co., 114 U.S. 87, 5 S.Ct. 1069, 1075, 29 L. Ed. 96.”

*Grand Rapids Show Case Co. v. Weber Show Case & Fixture Co.*, 38 F. 2d, 730, C.C.A. 9.

“The rule on that point is an aged one, and is stated in *Smith v. Nichols*, 21 Wall. 112, 88 U.S. 112, 119, 22 L. Ed. 566, as follows: ‘\* \* \* But a mere carrying forward or new or more extended application of the original thought, a change only in form, proportions, or degree, the substitution of equivalents, doing substantially the same thing in the same way by substantially the same means with better results, is not such invention as will sustain a patent. \* \* \*’”

*Bingham Pump Co. v. Edwards*, 118 F. 2d, 338, 340 C.C.A. 9.

We cannot emphasize too much that a novel idea is not patentable; that the only thing patentable is the novel means by which such idea is rendered useful. That in determining the validity of the Ballou patent, the controlling consideration is, does such a patent disclose novel means. If not, the fact that one had conceived a more extended or different use for an old thing composed of

old means is not invention under our patent law. In this rule the term "means" is synonymous with the mechanical device or ingredients by which a given effect is secured. This rule of law is emphasized and applied in *Measuregraph Co. v. Grand Rapids Show Case Co.*, 29 F. 2d, 263, 275, C.C.A. 8, where the Court said:

"Clearly, Stocke had the idea of obstructing the throat (of the machine) to prevent errors, but ideas are not patentable. It is the means, or thing by which they may be accomplished that is within the law."

Cf. *Dyer v. Sound Studios of New York, Inc.*, 85 F. 2d, 431, 432, C.C.A. 3;

*Greenewalt v. Stanley*, 54 F. 2d, 195, 196, C.C.A. 3;

*Farmers Cooperative Exchange v. Turnbow*, 111 F. 2d, 728, C.C.A. 9.

Ballou was not the first inventor or discoverer of printing identifying matter upon a card nor of enclosing such card in a celluloid cover or envelope. It cannot be disputed that all this is fully disclosed in the Goodsell & Maynard patent. Nor was Ballou the first inventor of a bleeding ink, nor of a solvent which would dissolve celluloid and in dissolving it deface or dissolve the ink.

At most, Ballou only took the Goodsell-Maynard identification card and selected a well known ink from an old text book to fit his identification card together. *Appellant's own expert testified*:

"Q. How long have you known of solvents which would dissolve a plastic cover like cellulose acetate, and also dissolve an ink? A. For the past 30 years at least.

Q. Is that well known in the art? A. Oh, yes.

Q. Are there any textbooks that show that? A. Yes. There is one book by Krieger; there is another book by Wiborg; there are German and British publications, innumerable of them, and the paint industries publish textbooks also.

Q. How old are those textbooks? A. I have used them since 35 years ago, some of them."

In *Kalich v. Paterson Pacific Parchment Co.*, 137 F. 2d, 649 at 651, this Court said:

"Patentees are not entitled to a monopoly for the judicious use of materials the use of which would produce the result to be expected from such selection. Recognition is not invention."

The Supreme Court, on May 21, 1945, rendered its opinion in *Sinclair & Carroll Co., Inc. v. Interchemical Corp.* The case involved a patent on a printing ink. Invention was asserted in the selection of butyl-carbitol as a solvent because of its peculiar quality of being relatively non-volatile at ordinary room temperature, but highly volatile at a temperature of 150° C, a temperature at which paper can be safely heated without burning, although such a relatively non-volatile solvent at ordinary room temperature, but highly volatile at such higher temperature, produced an ink which would not dry at room temperature, but which would dry instantly upon application of heat after printing. The Supreme Court held no patentable invention existed in such selection of such solvent for its particular known properties, saying:

"Reading a list and selecting a known compound to meet known requirements is no more ingenious than selecting the last piece to put into the last opening

in a jig-saw puzzle. It is not invention. The judgment below is reversed."

Such holding was not revolutionary. On the contrary, it was the mere application of a well-established doctrine of patent law:

"It is not invention to substitute superior for inferior materials in making one or all parts of a machine or manufacture. \* \* \* There being no invention in substituting superior for inferior materials, there is certainly none in selecting from a number of materials, recommended by a prior patentee, that one which is best adapted to the purpose in view (*Welling v. Crane*, 14 Fed. 571 (1882)), and none in substituting one well-known form of a particular material for another well-known form of the same material." (*Deller's Ed., Walker on Patents*, Vol 1, pp. 179-180.)

No new or unexpected result was secured by Ballou in selecting bleeding ink for the printed matter for its known bleeding property when subjected to solvents. The testimony of Appellant's expert establishes (1) that inks having such property were well known long prior to Ballou's asserted invention; (2) that it would require invention to produce an ink by which the printing could be performed and not be subject to the dissolving action of the solvent used to dissolve the celluloid cover. Selection of a bleeding ink so dissolvable with the solvent for celluloid is the only differentiation from the card or label disclosed in the Goodsell-Maynard Patent 1,071,226, even if it be assumed that there existed an ink in which the printing could be performed, which ink would not be dissolved by

the action of acetate solvent contrary to the testimony of Appellant's expert [R. 95-110], who stated:

“No printing ink has yet been made that will withstand the action of acetate solvent. All vehicles that are used in printing ink will break down under the action of any acetate solvent.” [R. 95.]

In *Abbott Machine Co. v. Universal Winding Co.*, 137 F. 2d, 166, at 169, the Court of Appeals, First Circuit, said:

“We only mean that now-a-days the emphasis in cases of this sort is less upon an analysis of the machine to see whether or not its parts cooperate to produce some new and useful result, and more upon an analysis of the machine and of the prior art to see whether or not the faculty of invention was required to put its parts together in such a way as to accomplish that new and useful result. This is illustrated by the recent case of Cuno Engineering Corp. v. Automatic Devices Corp., 314 U.S. 84, 62 S.Ct. 37, 86 L. Ed. 58. In this case there is no discussion of the question of whether or not the parts assembled cooperate with one another, the court holding simply that although a new and useful result was achieved, it was not achieved by an exercise of the inventive faculty in putting the combination together. The court said (314 U.S. at page 88, 62 S.Ct. at page 39, 86 L. Ed. 58) citing the Altoona Publix Theatres case *supra*, that in its opinion ‘the Mead device was not the result of invention but a “mere exercise of the skill of the calling”, an advance “plainly indicated by the prior art”’; that the question before it in the case was ‘whether it was invention for one skilled in the art and familiar with Morris and Copeland, and with the extensive use of the automatic thermostatic control of an electric heating circuit, to apply the

Copeland automatic circuit to the Morris removable heating unit in substitution for a circuit manually controlled' and it cited Hailes v. Van Wormer, and the cases which followed it, not in support of the test of cooperation of parts, but for the proposition that 'More must be done than to utilize the skill of the art in bringing old tools into new combinations.' "

The patent law does not recognize that the result, effect or purpose to be accomplished constitutes an invention, but that it is the mechanical means or instrumentalities by which the object sought is attained that is patentable under the statute, and that in determining whether or not an invention has been made, the Court should look at the machine, process or the manufactured article and ascertain how its cooperative parts are assembled and determine whether such assemblage is novel and whether to so assemble such parts required invention. Mere novel ideas or novel use of an old assemblage of instrumentalities does not constitute invention under the patent law. The pertinency in this case of this observation is that even if Ballou was the first to conceive that a useful purpose could be filled by imprinting upon a card in a bleeding ink, enclosing the card in a thermoplastic cover (e. g., celluloid or cellulose acetate) so that if the composite cover card be subjected to a solvent which would dissolve the cover it would necessarily cause the printing to be affected by the solvent, such conception did not amount to patentable invention *unless* invention was required to make such combination. In other words, a mere novel idea or concept (as it is sometimes referred to) is not patentable. The invention must exist in the *means* by which such concept is embodied in useful form. The Ballou patent does not disclose any physical part not in

the Goodsell-Maynard composite card. This principle has been considered in a great many adjudicated cases. In an early decision by the Supreme Court (*Aron v. Manhattan Railway Co.*, 132 U.S. 84) the Court adopted the opinion of Judge Wallace in the trial court (then Circuit Court) wherein Judge Wallace said:

“The patentee is entitled to the merit of being the first to conceive of the convenience and utility of a gate opening and closing mechanism which could be operated efficiently by an attendant in the new situation. His right to a patent, however, must rest upon the novelty of the means he contrives to carry his idea into practical application. It rarely happens that old instrumentalities are so perfectly adapted for a use for which they were not originally intended as not to require any alteration or modification. If these changes involve only the exercise of ordinary mechanical skill, they do not sanction the patent; and, in most of the adjudged cases where it has been held that the application of old devices to a new use was not patentable, there were changes of form, proportion or organization of this character which were necessary to accommodate them to the new occasion. The present case falls within this category.”

The Court of Appeals, Seventh Circuit, in *Voightmann, et al v. Perkinson, et al*, 138 F. 56, at 57, said:

“It is possible that Voightmann was the first to conceive that windows thus constructed would be a valuable adjunct to fire proof buildings. If so, it is the previousness of his conception that constitutes the merit of his so-called invention; for the mechanical embodiment of that conception is old. But it does not follow that a conception is patentable merely because it is first in time. Concept, alone, is not patent-

able. Concept must be accompanied by mechanical embodiment; and, as the law now stands, the mechanical embodiment, to make the invention patentable, must itself be unanticipated.

"Now in Voightmann's patent, every mechanical element described is found to have pre-existed; to have pre-existed in the form utilized by Voightmann; to have pre-existed performing the functions performed in Voightmann's device; and performing those functions to the same result. Voightmann possibly has pointed out to the world a wider use of the pre-existing art than was before known. But the discovery of an enlarged use is not, of itself, patentable invention."

See, also:

*Page Steel & Wire Co. v. Smith Bros. Hardware Co.*, 64 F. 2d, 512, 514, C.C.A. 6;

*Kellogg Switchboard & Supply Co. v. Michigan Bell Telephone Co.*, 99 F. 2d, 207, 211-12.

"We are, however, primarily concerned with the means disclosed by Trotter for providing variation in the stroke of the ram, for, however meritorious may be the inventor's thought in terms of result, unless the means adopted in attaining such result are novel and denote invention, either separately or in combination, he may not have a valid patent, for we are dealing with a machine and not a method. *Reo Motor Car Co. v. Gear Grinding Machine Co.* (C.C.A.) 42 F. (2d) 965, 968."

*Detroit Stoker Co. v. Brownell Co.*, 89 F. 2d, 422, 423, C.C.A. 6.

As said in *New York Belting & P. Co. et al v. Sierer, et al*, 149 F. 756, 769:

“The only new thought possible in the Furness patent is that rubber or yielding tile will bend and stretch more easily and more readily and safely than those made of wood, stone, brick, cement or iron. To ‘think’ that, when it was common knowledge, and only required the action of memory, was not the kind, degree, and quality of ‘thought’ mentioned and referred to by the Supreme Court of the United States in *Cash Reg. Co. v. Cash Indicator Co.*, 156 U.S. page 514, 15 Sup.Ct. 434, 39 L. Ed. 511. The thought there referred to is the conception or the origination of an idea, not the recalling to memory or the mere remembrance of a fact known or presumed to be known.”

The Walsh & Caprio patent 2,079,641 describes and discloses both a process and an article of manufacture resultant from such process which completely anticipates Claims 1, 2, 4 and 5 of the Ballou patent. This patent states:

“An object of our invention, therefore, is to provide a cement which will not cause blushing, bubbles, or pockets and will not cause colors to run or bleed.”  
[Walsh-Caprio, p. 1, ll. 19-22.]

The drawings show a print or card 1 “having a paper base,” and “having an outer colored surface 2.” [ll. 44-47.]

The patent states:

“It is assumed for the purposes of illustration that the color or colors of the print 1 have a tendency to run or bleed when the ordinary volatile liquid solvents or cements are used. To overcome this tendency of the colors to run or bleed, we use between sheet 4 and print 1, a cement 5 in sheet form

comprising substantially non-volatile solvents for the cellulosic plastic, preferably combined with at least a small proportion of the particular cellulosic plastic. The presence of at least a small proportion of the cellulosic plastic is particularly preferred where the non-volatile solvents are of an oily nature, in order that the cement may be maintained in sheet or other solid form. The use of a proportion of the cellulosic plastic also aids in producing a final product which is substantially homogeneous throughout, except for the print or its equivalent." [p. 1, col. 1, l. 54, to col. 2, l. 12.]

The patent contains complete formulae setting forth in detail the composition of the so-called thermoplastic cements. Formulae A and C refer to cellulose acetate and formulae B and D refer to cellulose nitrate as the main ingredients and the other chemicals in the formulae as plasticizers or thinners. "Cellulose acetate" and "cellulose nitrate" as well as celluloid are well known clear, plastic substances, all usable for covering the surface of an identification card. They have no visible physical differences. Either of these correspond with exactitude to celluloid or the "different transparent materials" which may be used instead of celluloid as set forth as equivalents in the Ballou patent. Plaintiff uses cellulose acetate in covering his cards. Further reference to the soluble or bleeding or smearing character of the color or ink is contained in this Walsh-Caprio disclosure, p. 2, col. 1, ll. 21-28, and it is to be noted that in the article claims 3 and 4, which claim the composite sheet produced, reference is made to one of the sheets which bears bleeding colors. It is not possible to differentiate the Ballou identification card from the composite sheet or identification card produced in accordance with the Walsh-Caprio disclosure.

Does the Written Description and the Disclosure of  
the Ballou Patent Comply With the Requirements  
of the Patent Statute R.S.U.S. 4888, 35  
U.S.C.A., Sec. 33? If Not the Patent Is Void.

The District Court realized that Appellant's case presented a dilemma. Either the Ballou patent does not disclose and claim a patentable invention or the patent is invalid because it does not contain a written disclosure of the invention and a claim specifying the invention.

Under the Patent Statute the Ballou patent does not contain a sufficient disclosure to enable one skilled in the art to make the article claimed therein *unless the card, its composition, etc. was common knowledge; unless the so-called distinguishing matter printed on the card was common knowledge; unless the composition of the cover was common knowledge; unless the firm securance of the cover to the card was common knowledge; unless the ink or coloring in which distinguishing matter is superposed on the card was a matter of common knowledge, and unless it required merely the selection of an ink for its known property of being soluble in the same solvent that would dissolve the cover.* Therefore, either the Ballou patent is invalid because of such insufficient description or it is invalid for want of invention because all these factors were part of the common knowledge and it required no invention to select these elements and put them together in the form and manner claimed in the Ballou patent.

Inasmuch as Ballou in the Patent Office admitted by the cancellation of Application Claim 6 [R. 52] that the sole novelty claimed by him was the use of an ink soluble in the solvent which would dissolve the cover, nothing patentable remains disclosed in either of Claims 1, 2, 4 or 5

of the patent unless such an ink was unknown and not at hand for selection for use of such property. If the Court could disregard and set aside the uncontradicted testimony of Appellant's expert Horwitz and conclude that it required invention to produce an ink or coloring matter which would be soluble in the solvent which would dissolve the ink or coloring matter, then the Ballou patent sets forth merely a problem to be solved. The patent law authorizes the grant of patents for solving patents and not for stating them.

"A patent is granted for solving a problem, not for stating one. Its description must explain the invention itself, the manner of making it, and the mode of putting it into practice. In the absence of knowledge upon these points, the invention is not available to the public without further experiments and further exercise of inventive skill. A claim for a combination which embraces an element only in case it is made capable of being employed in the combination and without disclosing means of adapting it, discloses nothing definite."

*Columbia Motor Car Co. v. C. A. Duerr Co.*, 184 F. 893, 908, C.C.A. 2.

In *Permutit Co. v. Graver Corp.*, 284 U.S. 52 at 60, it is said:

"\* \* \* The statute requires the patentee not only to explain the principle of his apparatus and to describe it in such terms that any person skilled in the art to which it appertains may construct and use it after the expiration of the patent, but also to inform the public during the life of the patent of the limits of the monopoly asserted, so that it may be known which features may be safely used or manufactured without a license and which may not."

In the absence of any such teaching in the Ballou patent it falls within the decision of *General Electric Co. v. Wabash Appliance Corp.*, 304 U.S. 364, wherein neither the claims nor the specification taught what size or contour of comparatively large grains of tungsten prevented substantial sagging or offsetting. (Cf. *Farmers Co-operative Exchange v. Turnbow*, 111 F. 2d, 728, 731, C.C.A. 9.)

### Conclusion.

It is respectfully submitted that the appeal judgment should be affirmed.

Respectfully submitted,

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